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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,878	09/11/2003	Kevin J. Zilka	SVIPGP002B	8771

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,878

Applicant(s)

ZILKA ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,18-20,44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,18-20,44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on August 24, 2006, wherein:

Claims 1-2, 4-13, 18-20, and 44-45 are currently pending;

Claims 1-2, 4-13, 18-20, and 44-45 have been amended;

Claims 3, 14-17, and 21-43 have been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has a step of ***allowing the manual selection of a file***.

"Allowing" only requires making an action possible, not necessarily performing the action. Using terms like "allowing" or "permitting" an action, e.g. "allowing a user to select". Again, this is distinct from actually doing the action, e.g. selecting.

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing ***a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier***.

First, it is not clear what applicant defines as a file. Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus **associating** the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, **wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents**

What does the applicant mean by associating the file with the identifier?

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with? Secondly, the applicant states that the notes are stored in association with at least one

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identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes? Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file?

The applicant has a step of ***associating a plurality of patents with the at least one identifier***. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property. Thus, how can a plurality of patents be associated with one patent number?

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier. The applicant then adds the language "wherein the manually entered notes. at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. What does the applicant mean by accessible? It is not clear what applicant is claiming in this step.

The applicant then has added the language that "wherein a set of patents is *reported by* – what does the applicant mean by "reported"?

The applicant then states *displaying a technology mapping depicting one category of technology utilizing a graphical user interface and displaying statistics regarding a number of patents of the set in each category of technology.*

First, applicant only claims one category of technology in the displaying of a technology mapping. Then the applicant claims displaying statistics in each category of technology. How can one category become each category?

Applicant then claims displaying first additional information associated with at least a portion of patents of the set, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language.

The applicant states in the claim language "that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail". This is unclear. What does the applicant mean by "made accessible?"

In Claims 5 and 6, it is unclear what the applicant means by the language "the at least one identifier is determined utilizing an add icon" or "a modify icon".

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

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In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant amended the invention from a method to a system but does not provide any structure to the system.

The Examiner finds that because claim(s) 1-2, 4-13, 18-20, and 44-45 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

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Referring to Claims 1, 18, 19, 20, 44 and 45

Rivette discloses a method, computer program product embodied on a computer readable medium and a system (page 9 [0289-0291] page 10 [0294]) for organizing patents utilizing a computer-implemented system, comprising:

computer code for performing the steps of the method [0012] [0289], comprising:

displaying (display unit (1122) page 9 [0292]) a notes field for receiving manually entered notes (Fig. 4 Notes Mode (414) (Figure 134 (13408) [1200-1202] [0255-0257] Figs. 125-143 [0314] [0384] [0326]);

storing the manually entered notes in association with at least one identifier (patent number) (Fig. 111; Figure 134 save button [0380-0387]);

allowing the manual selection of a file ([0373] [0383] Figure 134 (13404);

storing the manually selected file in association with the at least one identifier (patent number) by providing a correspondence between the file and the at least one identifier wherein a manually selected first file is capable of being associated with a first identifier (patent number) corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group (Figures 117-119 and Figures 133 and 134 (13304) Analog Special Effects; [0264] a group is a data structure that includes a collection of patents [0326-0329] [0330-0344] [0373-0379] [0393]) ; and

associating a plurality of patents with the at least one identifier (Figure 122; [0265]);

wherein the manually entered notes and the patents are accessible by subsequent selection of the at least one identified (Figures 117-120, 122, 133, 134, [1157-1162] [0373-0387] [0329])

wherein a set of patents is reported by;

displaying a mapping depicting at least one category of technology utilizing a graphical user interface (page 2 [0025], page 7 [0262-0268]; pages 8-9 [0277] [0848] Figure 18 [1101-1110]),

displaying statistics regarding a number of the patents of the set in each category of technology ([0025] [0262] [0266] [0277] Figure 102-105),

displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon (Figs. 148, 117-120, 122, 133, 134, 153 [0377] [1157-1162]),

wherein the first additional information includes a list of patents of the set associated with one category of technology ([0020], [0262, 0264-0268], [0331] [1027-1028]),

displaying additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from a group consisting of a patent number, status, an exemplary claim, and an exemplary figure ([0377], Fig. 7, Fig. 45 (4512), Figs. 111-112; Figure 148; [1157-1162]),

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface (Figs. 111-112);

wherein said method is at least in part carried out utilizing the computer implemented system (Fig. 3-4).

Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs. 57, 125, 117). Rivette discloses technology and competitor analysis [0262—0268]. However, Rivette does not explicitly disclose displaying a technology mapping (although page 2 [0025] does not exclude technology mapping) depicting at least one category of technology or wherein the first additional information includes a list of patents of the set associated with one category of technology, or wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, or wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface or wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re*

Gulack, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known. Furthermore, because of the way this step is worded, it could encompass a person e-mailing another person to come look at the notes and files.

E-mail, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be attaching a file and emailing it to another computer or simply having a hyperlink in the email. Industry has utilized computers for years as a way of tracking and documenting information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication since it is fast and efficient and reliable way of communication.

Referring to Claims 2, 4-6:

Rivette discloses a method wherein the at least one identifier is determined by selecting an already existing identifier (Figure 147 and 117-120, 133-134).

It is old and well known to have a method wherein the at least one identifier is determined by selecting an already existing identifier utilizing a pull-down menu. For example, while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search.

It is also old and well known to add a file and thus create a new file with a new identifier or modify the name to a file thus creating a new identifier.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a pull-down menu, an add icon or a modify icon to the disclosure of Rivette so as to allow for easy access to the identifiers.

Referring to Claims 7-11:

Rivette discloses wherein a notes field allows a user to cut and paste notes (Fig. 58, Fig. 137 (Note ToolBar (13706)), wherein the file is selected utilizing a file structure field (Fig. 58), wherein the file structure field includes a file tree structure (Fig. 58), wherein the file structure field allows a user to browse various folders where files have been previously stored, Fig. 58), and wherein the file structure is displayed simultaneously with the notes field on the same interface (Fig. 58 Figures 117-120, 133-134, [1157-1162], [1193]).

Referring to Claim 12:

Rivette discloses wherein the patents associated with the at least one identifier are identified by searching a database of already existing identifiers (Fig. 6, Figs. 12B-12L, Figure 148).

Referring to Claim 13:

Rivette discloses wherein the database is a comprehensive database of all patents issued by at least one government agency (Document database [0310-0311], Patent bibliographic database [0318-0322] [0806-0807] [0418-0422] [0388-0417])

Response to Arguments

4. Applicant's arguments filed August 24, 2006 have been fully considered but they are not persuasive.

The Examiner has maintained the rejection under 35 USC 112, second paragraph. The amendments to the claims only include computer code language and do not further clarify the limitations.

Applicant states that applicant's invention allows a user to associate patents with at least one identifier with additional notes associated therewith and obtain technology related metrics regarding a set of patents. Applicant states that applicant's invention teaches a drill-down technique for accessing information.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a drill-down technique for accessing information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant's claim language reads:

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associating a plurality of patents with the at least one identifier;
wherein the manually entered notes, at least one of the manually selected files
and the patents are accessible by subsequent selection of the at least one identifier;
wherein a set of patents is reported using:
displaying a technology mapping, displaying statistics.

Applicant has not tied the patents that are reported to the identifier or the notes
or the files.

Applicant appears to be displaying information in 3 interfaces. The type
information displayed is not functionally related to the method steps or the structure of
the system. The invention does not search for the technology or map the technology.
The invention does not perform a statistical analysis on the technology. It is not even
clear where the set of patents that are being displayed are generated or how they are
generated or how they would possibly connect with the identifier or the notes.

The applicant states that there is not even a suggestion of any sort of statistics
being displayed in a first interface, first information displayed in a second interface, and
the second additional information displayed in a third interface. Thus, the applicant is
simply displaying information in 3 interfaces. Rivette discloses 3 interfaces (Figure
117).

Thus, the Examiner stated that these differences are only found in the
nonfunctional descriptive material and are not functionally involved in the steps or
structure recited. The data does not alter how the system functions or the steps are
performed. The data does not alter or reconfigure the method steps but rather only

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means something to the human mind. The claim language does not provide for the method steps to actually do the mapping but rather just display the mapping. The displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a drill-down technique for accessing information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner asserts that the prima facie case of obviousness has been met. The knowledge is available to one of ordinary skill in the art and thus, there is a reasonable expectation of success.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

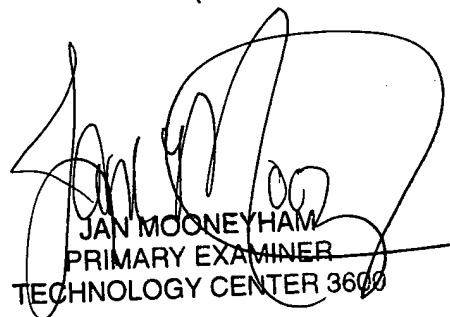
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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